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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			GILLIGAN, CHRISTOPHER L	
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3626

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,101

Applicant(s)

HAYES, FRANCIS E.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, and 10-34 is/are pending in the application.
- 4a) Of the above claim(s) 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-28, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 9/6/05, the following has occurred: claims 4 and 9 have been canceled, claims 1-3, 5-8, 10-28 have been amended, and claims 33-34 have been added. Claims 29-32 are withdrawn, therefore, claims 1-3, 5-8, 10-28, and 33-34 are now presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 12 and 13 recite "the program code." However, claim 11, from which claims 12 and 13 depend, has been amended to recite a "second user interface" rather than "program code." Therefore, there is insufficient antecedent basis for this limitation in the claims. For examination purposes, it will be assumed that claims 12 and 13 should recite "the second user interface".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 6, 7, 19, 21-23, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745.

7. As per claim 1, Scheinuk teaches a system for generating a certificate of insurance, comprising: a database operable to store insurance coverage information corresponding to each of a plurality of insured parties (see paragraph 0009); a first user interface communicably coupled to the database and operable to determine if a first user is an insurance producer or insurer authorized to enter information into the database (see paragraph 0077) and, if the first user is authorized, to accept insurance coverage information corresponding to an insured party from the first user and to store the accepted insurance coverage information in the database in association with the insured party (see paragraph 0010); and a second user interface communicably coupled to the database and operable to: accept an identification of one of the plurality of insured parties from a second user and to determine if the second user is a certificate requester, different than the insurance producer or insurer, authorized to receive a certificate of insurance related to the identified one of the plurality of insured parties (see paragraph 0061 and 0065); and if the second user is authorized, generate a certificate of insurance describing at least a portion of the insurance coverage information stored in the database and corresponding to the identified one of the plurality of insured parties (see paragraph 0072).

8. As per claim 2, Scheinuk teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about a plurality of passwords corresponding to at least one of the plurality of insured parties, each of the passwords being associated with a different subset of the insurance coverage information corresponding to the one of the plurality of insured parties (see paragraph 0049 and Table 2); and the second user

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interface is operable to accept a password from the second user and to generate the certificate of insurance such that the generated certificate of insurance contains a subset of the insurance coverage information associated with the entered password (see paragraph 0061).

9. Claims 6 and 7 recite substantially similar method limitations to those already addressed in system claims 1 and 2 and, as such, are rejected for similar reasons as given above.

10. As per claim 19, Scheinuk teaches the system of claim 1 as described above. Scheinuk further teaches the first user interface is operable to accept an identification of at least one type of insurance carried by a corresponding one of the plurality of insured parties and to store the identified at least one type of insurance in the database in association with the insured party (see paragraph 0065); the second user interface is operative to: display only the identified at least one type of insurance corresponding to the identified one of the plurality of insured parties (see paragraph 0066); allow the second user to select at least one of the displayed at least one type of insurance (see paragraph 0066); and generate the certificate of insurance based on the selected at least one type of insurance (see paragraph 0069).

11. As per claim 21, Scheinuk teaches the system of claim 19 as described above. Scheinuk further teaches the first user interfaces is operative to input an indication that the words "Endeavor to" may be omitted from a cancellation clause in a certificate of insurance associated with the insured party and to store the indication in the database in association with the insured party (see paragraph 0062); and the second user interface is operative, responsive to the association of said indication with said insured party, for preventing removal of the words "Endeavor to" in a cancellation clause of the generated certificate of insurance (see paragraph 0062).

12. As per claim 22, Scheinuk teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to present a list of insurance

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options that includes those listed and to permit the first user to select at least one of the list of insurance options and to store the selected at least one insurance option in the database in association with the insured part (see paragraph 0071); the second user interface is operative, responsive to the selected at least one insurance option to display only the selected at least one insurance option (see paragraph 0066).

13. As per claim 23, Scheinuk teaches the system of claim 19 as described above.

Scheinuk further teaches the first user interface is operative to input revised additional insured wording to be included in the generated certificate of insurance (see paragraph 0071); and the second user interface is operative to insert the revised wording into the generated certificate of insurance in response to an indication of an additional insured option by the second user (see paragraph 0071).

14. As per claim 33, Scheinuk teaches the system of claim 2 as described above. Scheinuk further teaches a third user interface communicably coupled to the database and operable to determine if a third user is one of the plurality of insured parties and, if so, to accept at least one password and an identification of a subset of the insurance coverage information stored in the database and associated with the third user and to associate the at least one password with the identified subset of the insurance coverage information (see paragraph 0049 and Table 2).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 3, 5, 8, 10, 24-26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of Luchs et al., U.S. Patent No. 4,831,526.

17. As per claim 3, Scheinuk teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about an approving party corresponding to at least a subset of the insurance coverage information corresponding to at least one of the plurality of insured parties (see paragraph 0049); and the second user interface is operative to send an electronic message prior to generating the certificate of insurance, the electronic message including at least a portion of a proposed certificate of insurance and to generate a certificate of insurance (see paragraph 0089). Scheinuk does not explicitly teach only generating a certificate of insurance if an approval response is received from the approving party. Luchs teaches only generating an insurance document if an approval response is received from an approving party (see column 6, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of reducing errors in the generation of certificates of insurance by first checking with an approving party (See paragraph 0006 of Scheinuk).

18. As per claim 5, Scheinuk in view of Luchs teaches the system of claim 3 as described above. Scheinuk further teaches the at least a portion of the proposed certificate of insurance included in the electronic message is modifiable by the approving party and the generated certificate of insurance is generated according to modifications made by the approving party (see paragraphs 0089-0090).

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19. Claims 8 and 10 recite substantially similar method limitations to those already addressed in system claims 3 and 5 and, as such, are rejected for similar reasons as given above.

20. Claims 24-26 contain substantially similar additional limitations to those already addressed in claims 3 and 5 and, as such, are rejected for similar reasons as given above.

21. Claim 34 recites substantially similar additional limitations to those already addressed in claim 3 and, as such is rejected for similar reasons as given above.

22. Claims 11-18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of Grow, U.S. Patent No. 6,694,315.

23. As per claim 11, Scheinuk teaches the system of claim 1 as described above. Scheinuk further teaches the second user interface is operative to accept proposed text to be entered into the generated certificate of insurance and enter a complete sentence into the generated certificate of insurance such that the complete sentence is not modifiable by the second user (see paragraph 0062). Scheinuk does not explicitly teach a box receiving text and forming complete sentences to be entered in said box. Grow teaches an automated document creation system that includes boxes for entering text to be automatically entered in legal documents (see column 6, lines 23-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of the document creation process within Scheinuk and to provide custom tailored application for different entities within the document creation process (see column 2, lines 1-4 of Grow).

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24. As per claim 12, Scheinuk in view of Grow teach the system of claim 11 as described above. Scheinuk further teaches the second user interface is responsive to whether or not any text was entered (see paragraph 0089).

25. As per claim 13, Scheinuk in view of Grow teach the system of claim 11 as described above. Scheinuk does not explicitly teach forming a complete sentence responsive to a selected one of a plurality of items listed within a pull down menu. Grow teaches forming complete sentences responsive to a selected one of a plurality of items listed within a pull down menu (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

26. As per claim 14, Scheinuk in view of Grow teach the system of claim 13 as described above. Scheinuk does not explicitly teach said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with an insurance type. Grow teaches said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with a predetermined event (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

27. Claims 15-18 recite substantially similar method limitations to those already addressed in system claims 11-14 and, as such, are rejected for similar reasons as given above.

28. Claims 27-28 recite substantially similar additional limitations to those already addressed in claims 11-12 and, as such, are rejected for similar reasons as given above.

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29. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of McKee et al., U.S. Patent No. 6,272,482.

30. As per claim 20, Scheinuk teaches the system of claim 19 as described above. Scheinuk further teaches the second user interface is operable to a requested number of cancellation days (see paragraph 0067). Scheinuk does not explicitly teach inputting a maximum and minimum number of cancellation days for comparison to a requested number of cancellation days and comparing this data to produce the error messages. McKee teaches the use of business rules to establish a maximum and minimum number of cancellation days (see column 4, lines 38-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these rules into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of complying with state laws regarding cancellation (see column 4, lines 61-66 of McKee).

Response to Arguments

31. In the remarks filed 9/6/05, Applicant argues in substance that none of the applied prior art, and Luchs in particular, teach the generation of certificates of insurance. However, in view of the amendments, the Examiner has now relied upon a new grounds of rejection in view of Scheinuk as detailed above. Therefore, it is respectfully submitted that the arguments are moot in view of the new grounds of rejection.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CLG

11/28/05



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